



#34/Response
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Masaaki HIROKLet al.)
Serial No. 08/943,238)
Filed: October 3, 1997)
For: ELECTRO-OPTICAL DEVICE)
)
)

Art Unit: 2814
Examiner: S. Rao

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with
The United States Postal Service with sufficient postage as First
Class Mail in an envelope addressed to: Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450, on May 29, 2003

Adelle M. Stampen

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Official Action mailed January 29, 2003 has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to May 29, 2003. Accordingly, Applicant respectfully submits that this response is being timely filed.

It is noted that the Official Action Summary and body of the Official Action appear to include a minor typographical error in listing an incorrect Serial Number of 08/943,233. The Official Action cover sheet includes the correct Serial Number of 08/943,238. It is requested that any confusion be clarified in the following action.

Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on November 24, 1999; January 3, 2000; October 5, 2000; December 12, 2000; January 10, 2001; June 4, 2001; July 3, 2001; November 13, 2001; and April 22, 2002. Applicant awaits consideration of the Information Disclosure Statements filed October 3, 1997; September 20, 2002, and May 9, 2003. A further Information Disclosure Statement is submitted herewith and careful review and consideration of this Information Disclosure Statement is requested.

Claims 41-110 are now pending in the present application, of which claims 41, 51, 61, 71, 81, 91, and 101 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance.

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The Official Action rejects claims 41-110 as obvious based on the combination of U.S. Patent 4,960,710 [sic] to Tanaka et al., JP 62-283664 to Aoyama, and U.S. Patent 5,181,132 to Shindo et al. As an initial matter, it is understood that the rejection should be based on 4,960,719 to Tanaka and not 4,960,710. If this understanding is incorrect, clarification is requested.

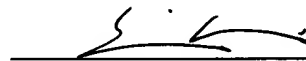
As stated in MPEP § 2143-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Official Action alleges that Tanaka teaches "forming an organic leveling film over the semiconductor film after said patterning thereof to provide a leveled upper surface (Fig. 8c, No. 26)." Applicant respectfully disagrees. As disclosed in column 4, line 37, layer 26 in Figure 8(c) is an n-a-Si layer, which does not correspond to the claimed organic leveling film. The Office Action further alleges that Tanaka teaches "forming an opening in said organic leveling film (Fig. 8c) and forming a pixel electrode over said organic leveling film through the opening (Fig. 8c, # 27), wherein said opening has a tapered configuration" Since Tanaka does not teach an organic leveling film as noted above, it is unclear which opening is being referred to and it does not appear that Tanaka discloses the claimed opening, pixel electrode, or tapered configuration.

Since Tanaka, taken alone or in combination with Shindo and Aoyama, fails to teach or suggest all the claim limitations, it is respectfully submitted that a *prima facie* case of obviousness cannot be maintained.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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